

REMARKS

Claims 1-26 are currently pending. Claims 24-26 have been withdrawn from consideration. In the Office Action mailed August 24, 2007, the Examiner concluded that Applicants affidavit filed March 15, 2007 was ineffective to overcome Epler et al. (U.S. Patent Application Publication 2003/0187615) as prior art with respect to the above-captioned matter. Accordingly, the Examiner reiterated the previously presented rejections of the pending claims as being anticipated by Epler et al.

With respect to Applicant's efforts to establish conception and diligence from a date before the priority date of Epler et al., the Examiner concluded that the evidence submitted was insufficient to establish diligence for the time periods of 4/19/2002-5/13/2002 and 5/13/2002-10/11/2002. Applicant has enclosed herewith further evidence of Applicant's conception and diligence including an additional §1.131 Declaration executed by the above-named Inventor as well as a §1.132 Declaration executed by Attorney Timothy E. Newholm outlining his efforts with respect to reducing to practice the above-captioned matter. The §1.131 Declaration of Inventor Barthell is further supported by six (6) pages of Appendix A and the §1.132 Declaration is further supported by the four (4) pages of Appendix B.

Although the Examiner cites various cases allegedly supporting the assertion that each and every day of a critical period in question must be accounted for, those cases are limited to exceptions not applicable here. The governing standard is that diligence is determined on a case-by-case basis. That is, the case law clearly demonstrates that diligence is demonstrated by the facts of a specific case and that, what might be considered non-diligent for one applicant under one set of circumstances, may be diligence for another applicant under another set of circumstances. The evidence provided herewith, in conjunction with the information previously provided, is believed to satisfy Applicant's burden with respect to establishing priority before the effective date of Epler et al. through conception before the priority date of Epler et al. and reasonable diligence to Applicant's filing date.

As most simply stated in *De Wallace v. Scott*, “No hard and fast rule can be laid down. What is or is not diligence in a given case must depend on its special facts and circumstances.” *De Wallace v. Scott*, 15 App. D.C. 157, 164 (App. D.C. 1899). It is further clearly developed that the determination of diligence must be tempered by reasonableness. In *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, a startup company was excused for waiting up to a year to get research notebooks witnessed because it was a “young, growing company.” *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1378, 231 U.S.P.Q. (BNA) 81 (Fed. Cir. 1986). As further stated in *Burnett v. Utsman*, “It is a principle of diligence that consideration must be given to the circumstances of the inventor, including his skill *and available time*”. *Burnett v. Utsman*, 46 App. D.C. 407 (App. D.C. 1917) (emphasis added).

Applicant has enclosed herewith an additional §1.131 Declaration executed by co-inventor Dr. Barthell. As evidenced therein, after conception of the subject matter of the above-captioned matter, co-inventor Dr. Barthell collaborated with various persons whose input and/or feedback was necessary with respect to reducing the conceived invention to practice. See Barthell Declaration, ¶6. The facts asserted in this additional declaration further evidence Dr. Barthell’s reasonable diligent efforts in reducing the subject matter of this application to practice.

Although each and every day is not explicitly referred to in these additional facts, in light of the collective collaboration required with respect to assessing the merits and feasibility of the present invention, as well as the relative complexity and infancy of the issues being addressed therein, the correspondence and communications referred to in the declaration generally take considerable effort to assemble. That is, it is only reasonable to allow those who are being queried a reasonable time to formulate appropriate responses and/or conduct the activities requested of them. This collaborative effort and Applicants diligence is further evidenced in the article titled “The Frontlines of Medicine Project Progress Report: Standardized Communication of Emergency Department Triage Data For Syndromic Surveillance” as published in the September 2004 issue of the *Annals Of Emergency Medicine*. A copy of the six (6) pages of this publication is

enclosed herewith and identified as Appendix A. Although specific sections of this publication are referred to the enclosed §1.131 Declaration, the entirety of the document evidences Applicants' on-going efforts with respect to reducing to practice the presently claimed invention during the period in question. The enclosed §1.131 Declaration and Appendix A, in conjunction with the materials provided in the March 15, 2007 filing, clearly evidence Applicant's reasonable diligence during the entire period in question. Indeed, except when he was waiting on results from others, applicant never let more than a few days pass without working on refining the invention. Barthell Declaration, ¶9. The additional materials provided, the §1.132 Declaration of Attorney Newholm, as well as supporting Appendix B, further evidence Applicant's diligence.

As also stated in MPEP §2138.06, "The diligence of attorney in preparing and filing patent application inures to the benefit of the inventor." The Section further explains that "Reasonable diligence is all that is required of the attorney [and] reasonable diligence is established if attorney worked reasonably hard on the application during the continuous critical period." MPEP §2138.06 further allows that "If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient [and that] work on a related case(s) that contributed substantially to the ultimate preparation of an application can be credited as diligence."

Applicant has enclosed herewith a §1.132 Declaration executed by Attorney Timothy E. Newholm. The statements set forth in the §1.132 declaration are further evidenced by the materials provided in Appendix A. Appendix A includes that information which supports Attorney Newholm's Declaration related to the diligent efforts in assessing the patentability of the conceived subject matter and includes evidence related to the diligent efforts of Attorney Durst in the preparation of the underlying patent application. Collectively, the documents provided herein evidence both the inventors working with counsel in the diligent preparation of a patent application and Mr. Newholm's and Mr. Durst's reasonable and diligent efforts in the preparation of the above-captioned application.

The materials provided herein, in conjunction with the materials previously provided, clearly evidence Applicant's conception of the claimed invention prior to the priority date of Epler et al. and further evidence the Inventor's reasonable diligence in reducing to practice the claimed invention. Accordingly, Applicant believes that Epler et al. has been disqualified as prior art with respect to the above-captioned application. Therefore, the rejections premised on Epler et al. must be withdrawn. As there are no other outstanding rejections, Applicant believes that the above-captioned application is in condition for allowance and respectfully requests a notice of allowance of claims 1-23.

The Examiner is hereby authorized to charge Deposit Account No. 50-1170 the amount of \$525.00 for the three-month extension of time necessary for consideration of this response. Although no additional fees are believed payable, the Office is hereby authorized to charge any additional fees that may be deemed due, or credit any overpayment, to Deposit Account No. 50-1170. The Examiner is cordially invited to contact the undersigned by telephone if it any matters remain which would otherwise hinder passage of this matter to issuance.

Respectfully submitted,



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